

**BOARD OF PATENT APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| In re application of: | Delaney et al. | | |
| Serial No.: | 09/656,320 | Group Art Unit: | 3691 |
| FILING DATE: | September 6, 2000 | Examiner: | Karmis |
| FOR: | Method For Usage Billing In An Internet Environment | | |

REPLY BRIEF OF PATENT OWNER ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants, by way of Reply, wish to address new issues and comments presented in the Examiner's Answer of February 16, 2007. The Examiner raises issue with the Applicants' arguments pertaining to the amendment to the claims submitted After Final and the elements of the algorithm as claimed. Accordingly, Applicants address this point below.

A. Examiner's Grounds of Rejection

1. Rejection of Claim 1 Under 35 U.S.C. §112

While the Examiner illustrates portions of the time-line associated the amendment After Final, the Examiner does not address the entirety of this request. Applicant had submitted an amendment after final on April 27, 2006, which included an amendment to claims 1, 6, and 11 to place the claims in the identical condition as the claims which were fully considered by the Examiner in the Office Action dated September 14, 2005. On May 30, 2006, prior to issuance of the Advisory Action in response to the After Final Response dated April 27, 2006, the Examiner indicated he would enter the amendment as the amendment did not necessitate a new search or raise new issues. However, when the Examiner issued the Advisory Action, there was no entry of the amendment indicated. This amendment to the claims was not originally submitted on July 28, 2006, rather is was originally submitted on April 27, 2006. It was the Examiner and the Examiner's Supervisor delay in responding to telephone calls that necessitated the Petition Under 37 C.F.R. §§1.127 and 1.181 to request entry of the amendment to the claims. Accordingly, the first request for this amendment to the claims was submitted timely and not initially on July 28, 2006.

2. Rejection Under 35 U.S.C. §103(a)

The Examiner utilizes the *Wright* reference as the primary reference in rejecting Applicants' claimed invention. However, the Applicants' Response to the Final Official Action and Brief in Support of Appeal distinguished *Wright*. More specifically, *Wright* discloses a method for charging a user for accessing data on a computer network. Applicants' invention discloses a method for billing for access to such data in a novel manner that is not taught, motivated, or suggested by *Wright*. While the Examiner asserts that the billing method of *Wright* may be considered to teach all of the elements claimed by Applicants, the Examiner's characterization of *Wright*, in such a case, lacks the fundamental elements of Applicants' claimed invention.

Applicants hereby incorporate by reference remarks pertaining to the *Wright* patent publication and the *Dialog* publication as discussed in the Brief in Support of Appeal submitted

September 15, 2006, and directs the Board of Patent Appeals to such remarks as demonstrating the various distinctions between the prior art, specifically *Wright*, and the claimed invention.

Applicants respectfully disagree with the Examiner's position that the rating plan of *Wright* is predetermined. A clear reading of *Wright* indicates that the items that will be subject to a charge are predetermined. "The units of measure include time, event, or functional units as predetermined by the service provider . . ." Paragraph 0026. It is these defined and predetermined units that is accessed by the user. There is no indication in paragraph 0026 of *Wright* that a weight score of these predetermined units is assigned to the unit prior to access by a user. In fact, *Wright* is clear that "the rating device 20 receives and rates each unit within a relatively short time after consumption". Paragraph 0028. *Wright* is not silent as to when the rating plan is applied. It is clear that the rating plan is assigned to the units consumed *after* consumption.

Furthermore, and on a more substantive level, Applicants claim a specific and novel manner for billing a user for accessing web server functions in a novel manner. As noted in independent claims 1, 6, and 11, a weight score is assigned to the web server function prior to use of the function by a user. It is this weight score, in association with the quantity of times the function associated with the weight score is accessed, that is applied to the usage calculation and the amount billed to the user. Neither *Wright* nor *Dialog* apply a weight score of individual functions to the usage calculation. Rather, the mathematical formula of *Wright* and *Dialog*, which are the same, do not account for different weights to be applied to different functions. In fact, both *Wright* and *Dialog* sum the total number of functions accessed and then apply the summation to a rate. In contrast, Applicants multiply the number of times a function is access with the weight assigned to the function *and then* sum this calculated amount for each accessed function. There is no teaching of this complete step in either *Wright* or *Dialog*.

To establish a rejection under 35 U.S.C. §103(a), all of the claim limitations must be

taught or suggested by the prior art.¹ With all due respect to the Examiner's position, Applicants respectfully disagree with the Examiner's interpretation that either *Wright* or *Dialog* teach the pre-assigned weight (W) limitation of Applicants. Furthermore, it is Applicant's position that the *Wright* and *Dialog* do not individually or in combination teach multiplying the number of times a function is accessed with the weight assigned to the function **and then** sum this calculated amount for each access function. Accordingly, the *Wright* and *Dialog* references, individually or when combined, are not sufficient to uphold a rejection under 35 U.S.C. §103(a).

As disclosed in the Brief in Support of Appeal, Applicants' invention includes a pre-assigned weight score for individual functions available on a computer network, and multiplying this weighted variable by the number of times each function was accessed or performed by the user. Applicants' claimed invention applies a different algorithm than either *Wright* or *Dialog* to assess how much to bill a user for accessing one or more web server functions. The mathematical algorithm, as claimed, is demonstrated in the Brief in Support of Appeal on page 11. Applicants apply a two step process. The first step is to calculate the total usage of the user based upon the web server functions accessed. This formula is defined as:

$$(F_1 * W_1) + (F_2 * W_2) + \dots (F_n * W_n) = U_{\text{Total}}$$

where, F_1 represents a total number of a first function performed by a user and W_1 represents the respective weight pre-assigned to F_1 . Similarly, F_2 represents a total number of a second function performed by a user wherein W_2 is the respective pre-assigned weight of F_2 etc. The total usage is then multiplied by a rate, R , to obtain a user's bill, according to the following formula:

$$U_{\text{Total}} * R = B$$

¹*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Applicants claimed these elements of the algorithm in each of the independent claims.

In contrast, neither *Wright* nor *Dialog* provide a teaching, suggestion, or motivation to apply the algorithm of Applicant to determine a bill for use of one or more web server functions. Rather, *Wright* and *Dialog* both sum the quantity of functions accessed, and then multiply the sum by a rate provided to the user. By utilizing different mathematical formulas that accounts for applying different weights to different web server functions, Applicants provide a different result than that taught by either *Wright* or *Dialog*.

Furthermore, not only do *Wright* and *Dialog* not teach all of the elements present in Applicants' claims, there is no suggestion or motivation to modify the teachings of *Wright* and *Dialog* such that one of ordinary skill in the art would find it obvious to incorporate such modifications. This assignment of rates to specific web server functions enables Applicants to apply a granularity of billing to a user that accurately portrays the web server functions utilized. In contrast, both *Wright* and *Dialog* assign a rate to a user and then apply this rate to the entirety of the web server functions accessed. Neither *Wright* nor *Dialog* can apply the granularity in billing the user for access to web server functions because neither *Wright* nor *Dialog* assign a weight directly to the web server function and then mathematically calculate the usage as taught by Applicants. Accordingly, it is this granularity in assessing the web server functions accessed by the user that is central to the Applicants' invention, but it is this granularity that both *Wright* and *Dialog* lack.

B. Conclusion

In view of the rejections presented by the Examiner in the Office Action and Examiner's Answer, it appears clear on the record that neither *Wright* nor *Dialog* teach all of the elements of Applicants' claimed invention, and further do not individually or in combination obviate Applicants' invention based upon the legal definition of obviousness. Although the prior art

patent cited by the Examiner relates to a method for billing a user for accessing a computer system, the method of billing of *Wright* and/or *Dialog* are different than the granularity in the billing claimed by Applicants. Accordingly, Applicants respectfully disagree with the Examiner's characterization of the prior art and submits that the Examiner has failed to show that *Wright* and *Dialog* obviate every element of Applicants' invention.

Applicants believe that those skilled in the art have failed to solve the problem as claimed by Applicants. Accordingly, for the reasons outlined above, Applicants respectfully requests the Board of Patent Appeals direct allowance of this application and all pending claims.

Respectfully submitted,

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